

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. STATUS OF THE CLAIMS

Claims 1-4 and 21-23 are pending.

Claims 5-20 are canceled.

Claim 1 is amended to further limit the composition mixture, wherein said mixture (A) has a first refractive index, and said polymethyl methacrylate powder (B) has a second refractive index, and wherein a difference of the first refractive index and second refractive index is 0.1 or less.

Support for such amendment can be found in the specification as filed, for example, page 6, lines 14-21.

No new matter has been added.

II. CLAIM REJECTIONS

Claims 1-4 and 21-23 are newly rejected under 35 U.S.C. 251, as being based upon a defective reissue declaration. See items 5 and 6 on pages 2 and 3.

Specifically, the Examiner contends that newly added claim 21 is narrower than one or more broader existing patent claims without either narrowing the broader patent claim by amendment or cancelling the broader claim.

The Applicants respectfully traverse this rejection as applied to amended claim 1 and previously presented claims 2-4 and 21-23.

The Applicants note that claim 1 has been amended to limit the moisture curable composition to the actual scope of the Applicant's invention. The Applicants further note that unamended claim 1 renders the patent wholly or partly inoperative or invalid by reason of claiming more than the patentee had a right to claim, due to the omission of an essential

limitation. The Applicants further note that all errors being corrected in this application did not result from any deceptive intent on the part of the Applicants.

The specification as filed discloses that transparency of the claimed composition is sufficiently improved when the difference in refractive index between the liquid phase and the solid phase is 0.1 or lower. See page 6, lines 14-21. However, the disclosure of claim 1 does not recite such limitation, thereby failing to teach a composition that exhibits excellent transparency. Absent such limitation, claim 1 fails to set out the metes and bounds of the Applicant's invention.

Applicants assert that additional support for this amendment can be found in the Examples as filed. Specifically, the data shows that the Applicants carefully monitored refractive index differences. Moreover, the Applicants noted that transparency was superior when the mixtures were mated to yield a low refractive index difference. See Table 2, page 12, lines 14-20. Moreover, Example 1 shows that when the refractive index of SILYL MAX450 was mated with that of MR13G by use of FTR8100, transparency was sufficient. Example 2 shows that when refractive indexes were not mated between two mixtures, the composition resulted in degraded transparency. These findings demonstrate that a low refractive index is an essential element of the claimed invention.

In view of the foregoing remarks, it is apparent that the inadvertent exclusion of the essential limitation resulted in the Applicants claiming more than they had a right to claim. Specifically, unamended claim 1 renders the patent wholly or partly inoperative or invalid because it claims a broader subject matter, i.e. compositions with insufficient transparency, than what the Applicants invented. Therefore, narrowing of claim 1 is necessary to limit the scope of the claim to the Applicant's actual invention.

The Applicants assert that the current amendment corrects the scope of the claimed invention by narrowing claim 1. Moreover, the correction of the error in claim 1 renders all pending claims allowable.

Therefore, it is believed that the rejection set forth in the Official Action is overcome by the amendment, and that the application is now in condition for allowance. Accordingly, such allowance is solicited.

The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.

Respectfully submitted,

Yasunobu HORIE et al.

By: Warren M. Cheek
Warren M. Cheek
Registration No. 33,367
Attorney for Applicants

WMC/cg
Washington, D.C. 20005-1503
Telephone (202) 721-8200
Facsimile (202) 721-8250
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